REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action mailed September 23, 2004. At that time, claims 1-28 were pending in the application. In the Office Action, the Examiner indicated that claims 11 and 23 contained allowable subject matter. At the same time, the Examiner rejected claim 15 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,513,433 issued to Inoue *et al.* (hereinafter "Inoue"). Claims 1-9, 12, 14, 16-22 and 25-28 were rejected under 35 U.S.C. §103(a) as being obvious to U.S. Patent No. 6,503,691 issued to Goodin *et al.* (hereinafter "Goodin") in view of Inoue. Claims 10 and 13 were also rejected under 35 U.S.C. 103(a) as being obvious in view of Goodin, Inoue, and in further view of U.S. Patent No. 5,997,993 issued to Bi *et al.* (hereinafter "Bi"). The Examiner also objected to the specification and rejected claim 24 under 25 U.S.C. §112. Finally, the Examiner rejected claims 1, 2, 4-9, 10 12, 13, and 14-15 based upon the judicially created doctrine of double patenting.

By this paper, claims 15 and 24 have been cancelled. Likewise, claims 11, 23, and 28 have been amended. In light of these amendments and the following remarks, reconsideration and allowance of the pending claims is respectfully requested.

I. Statement Concerning Common Ownership

The instant application ("Instant Application") and U.S. Patent No. 6,503,691 (*i.e.*, Goodin) were, at the time of the invention of the Instant Application, both owned by or subject to an obligation of assignment to Creo Inc.

More particularly, Applicants submit that, at the time of the invention that is the subject of the Instant Application:

(i) the subject matter of Goodin was owned by Creo SRL;

(ii) Creo Inc. owned 100% of Creo SRL, directly or through a wholly owned subsidiary; and

(iii) Horst NOGLIK, Tibor HORVATH, Joyce Diana Dewi Djauhari LUKAS and David A. MORGAN, the inventors of the claims of the Instant Application, were under an obligation to assign the Instant Application to Creo Inc.

II. Amendment to Claims 11 and 23

The Examiner has indicated that claims 11 and 23 would be allowable if rewritten in independent form to include the limitations of their respective base claims and any intervening claims. *See* Office Action, p. 9. By this paper, Applicants have done this by amending claim 11 to incorporate the features of claim 1 and amending claim 23 to incorporate the features of claim 16. Applicants respectfully submit that claims 11 and 23 are now in condition for immediate allowance.

III. Objection To The Specification

The Examiner has objected to the specification as not providing sufficient antecedent basis for claim 24. *See* Office Action, p. 2By this paper, claim 24 has been cancelled. Accordingly, Applicants submit that this objection is moot and respectfully request that it be withdrawn.

IV. Rejection of Claim 24 Based Upon 35 U.S.C. § 112

The Examiner has rejected claim 24 under §112 as being indefinite. *See* Office Action, p. 2. However, by this paper, claim 24 has been cancelled and thus, Applicants respectfully request withdrawal of this rejection.

V. Rejection of Claim 15 Under 35 U.S.C. § 102(e)

The Examiner rejected claim 15 as being anticipated by Inoue under 35 U.S.C. §102(e). *See* Office Action, p. 3. As a result of this paper, claim 15 has been cancelled. Withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 1-9, 10, 12, 13, 14-22 and 25-28 Under 35 U.S.C. §103(a)

The Examiner rejected claim 1-9, 12, 14,-22 and 25-28 as being obvious in light of Goodin and Inoue. *See* Office Action p. 3. Likewise, claims 10 and 13 were rejected as being obvious in light of Goodin, Inoue, and Bi. *See id.* at 6. As a result of this paper, claim 15 has been cancelled. With respect to other claims, however, this rejection is respectfully traversed.

The Examiner concedes that if Goodin qualifies as "prior art," this reference only be considered prior art under §102(e) because of the fact that Goodin and the Instant Applicant share at least one common inventor. *See id.* at 3. Moreover, as noted above in the Statement Concerning Common Ownership, at the time of the invention of the claims of the Instant Application, the subject matter of Goodin et al. was owned by Creo Inc. and the inventors of the claims of the Instant Application were under an obligation to assign the Instant Application to Creo Inc. Thus, 35 U.S.C. § 103(c) acts to disqualify Goodin from being prior art. As such, this reference cannot be used against the Instant Application under either 35 U.S.C. §102(e) or § 103(a).

Accordingly, because Goodin does not qualify as prior art against the Instant Application, the present §103(a) rejections based upon Goodin, in combination with Inoue and/or Inoue and Bi, are improper. Withdrawal of these rejections are respectfully requested.

VII. Double Patenting Rejection of Claims 1, 2, 4-9, 10 12, 13, and 14-15

The Examiner issued a double patenting rejection of claims 1, 2, 4-9, 12 and 14 based upon Goodin and Inoue. *See* Office Action, p. 7. Likewise, the Examiner also issued a double patenting rejection for claims 10 and 13 based upon the combined teachings of Goodin, Inoue,

and Bi. *See* Office Action, p. 8. In response to this rejection, Applicants have attached a terminal disclaimer to this paper that disclaims the terminal part of any patent granted on the Instant Application that would extend beyond the expiration date of Goodin. Applicants submit that this terminal disclaimer operates to overcome both of these double patenting rejections. Accordingly, withdrawal of these rejections is respectfully requested.

VII. Conclusion

Applicants respectfully assert that, based upon the foregoing, the present claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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